

ESTTA Tracking number: **ESTTA746893**

Filing date: **05/17/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	BB&HC, LLC		
Entity	Limited liability company	Citizenship	Michigan
Address	1610 Barlow St. Suite 201 Traverse City, MI 49684 UNITED STATES		

Attorney information	John Di Giacomo Revision Legal, PLLC 109 E. Front St. Suite 309 Traverse City, MI 49684 UNITED STATES john@revisionlegal.com Phone:231-714-0100		
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Applicant Information

Application No	86822838	Publication date	05/17/2016
Opposition Filing Date	05/17/2016	Opposition Period Ends	06/16/2016
Applicant	Earthy LLC 44 Green Bay Road Winnetka, IL 60093 UNITED STATES		

Goods/Services Affected by Opposition


Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Organic processed olives and olive oil

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2608911	Application Date	10/23/2000
Registration Date	08/20/2002	Foreign Priority Date	NONE
Word Mark	EARTHY DELIGHTS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Gourmet food items, namely specialty vinegars

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EARTHY DELIGHTS		
Goods/Services	Specialty oils, creams, vinegars, dried mushrooms, fresh mushrooms, dried peppers, fresh peppers, dried tomatoes, spices, beans, lentils, rice, and pastas		

Related Proceedings	Earthy, LLC v. BB&HC, LLC, Northern District of Illinois, Case No. 1:16-cv-04934.
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Attachments	76150799#TMSN.png(bytes) Opposition.pdf(113934 bytes) Exhibit A.pdf(231385 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JAD/
Name	John Di Giacomo
Date	05/17/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BB&HC, LLC

Opposer,

Proceeding No:

v.

EARTHY, LLC,

Applicant.

NOTICE OF OPPOSITION

BB&HC, LLC, a Michigan limited liability company, believes that it will be damaged by the registration of EARTHY, LLC's trademark application for EARTHY ORGANIC, which is pending under USPTO Serial No. 86,822,838 for registration in association with organic olive oil and organic honey. As grounds for its opposition, Opposer, by and through its attorneys Revision Legal, PLLC, states as follows:

PARTIES

1. BB&HC, LLC ("Tamarack Holdings" and "Opposer") is a limited liability organized under the laws of the State of Michigan.
2. Earthy, LLC ("Applicant") is a limited liability company organized under the laws of the State of Illinois with its principal place of business in Winnetka, Illinois.

OPPOSER'S BUSINESS

3. Tamarack Holdings is the parent company to several food production, processing, retail, and distribution-related business, including Earthy Delights, Inc. ("Earthy Delights"), which is a corporation organized under the law of the State of Michigan with its principal

place of business in Okemos, Michigan.


4. Since as early as 1987, Earthy Delights has been in the business of distributing specialty foods through retail and wholesale channels.
5. Among other products, Earthy Delights distributes specialty oils, creams, vinegars, dried mushrooms, fresh mushrooms, dried peppers, fresh peppers, dried tomatoes, spices, beans, lentils, rice, and pastas.
6. Earthy Delights' first sales of these food products in the Chicago area occurred in 1993.
7. In 1996, Earthy Delights expanded its retail operations to include an e-commerce store.
8. On April 4, 1996, Earthy Delights registered the <earthly.com> domain name to house this new operation, and, by December of 1996, began selling its full catalog of food products to consumers through the <earthly.com> website.
9. Beginning in 1999, Earthy Delights began selling its own line of oils and vinegars bearing the EARTHY DELIGHTS trademark both to businesses and directly to consumers and through both traditional and online retail channels.
10. Currently, Earthy Delights sells its food products across the world through its <earthly.com> e-commerce store and in 21 states through major and specialty retail outlets, including in Walmart, Meijer, and Spartannash stores.

OPPOSER'S TRADEMARK RIGHTS

11. In order to secure and protect its intellectual property rights in the wholesale and retail food market, Earthy Delights, in October of 2000, applied for and was granted a registered trademark by the United States Patent and Trademark Office for EARTHY DELIGHTS for use in association with "gourmet food items, namely specialty vinegars" (Reg. No. 2,608,911). See **Exhibit A**, EARTHY DELIGHTS Trademark Registration.

12. By virtue of its continued registration and use of the EARTHY DELIGHTS mark for in excess of five years, and through its filing of an Affidavit of Incontestability with the USPTO, the EARTHY DELIGHTS trademark registration is now incontestable.
13. Additionally, through its longstanding use of the EARTHY DELIGHTS mark in commerce in association with the sale and offering for sale of specialty oils, creams, vinegars, dried mushrooms, fresh mushrooms, dried peppers, fresh peppers, dried tomatoes, spices, beans, lentils, rice, and pastas since as early as 1999, Earthy Delights has also obtained common law trademark rights in and to the EARTHY DELIGHTS mark for use in association with those goods.
14. In 2016, and in a corporate restructuring, Opposer Tamarack Holdings acquired Earthy Delights, which is now a wholly owned subsidiary of Tamarack Holdings.
15. Subsequently, on March 11, 2016, Earthy Delights assigned both the EARTHY DELIGHTS trademark registration and its common law trademark rights in and to the EARTHY DELIGHTS mark to Tamarack Holdings.
16. This assignment was recorded with the USPTO on March 14, 2016.
17. Tamarack Holdings subsequently granted Earthy Delights an exclusive license to use the EARTHY DELIGHTS mark throughout the United States on March 11, 2016.
18. All rights and benefits arising out of Earthy Delights' use of the EARTHY DELIGHTS mark inure to the benefit of Opposer Tamarack Holdings, and Opposer Tamarack Holdings retained the right to litigate any claims arising out of or related to its trademark rights.

DISCOVERY OF APPLICANT'S BUSINESS AND INFRINGEMENT

19. On April 8, 2015, Applicant filed an application for registration of  earthy for use in

association with organic olive oil and organic honey on an intent to use basis and under Serial No. 86590689 (“‘689 Mark”).

20. Applicant’s application for registration of the ‘689 Mark was published for opposition, without Opposer’s knowledge, on August 12, 2015.

21. Consequently, the time period in which Defendant could have opposed Plaintiff’s application for registration of the ‘689 Mark closed on September 12, 2015.

22. Applicant’s ‘689 Mark is now the subject of a lawsuit pending between the parties in the Northern District of Illinois, Case No. 1:16-cv-04934.

23. On November 17, 2015, Applicant filed the instant application for registration of EARTHY ORGANIC in International Class 029 and for use in association with organic processed olives and olive oil under Serial No. 86822838 (“‘838 Mark”).

24. Applicant’s ‘838 Mark was published for opposition on May 17, 2016.

25. As the owner of both registered and common law rights in and to the EARTHY DELIGHTS trademark, Opposer believes that it will be harmed if Applicant’s ‘838 Mark is granted registration because Applicant’s ‘838 Mark so resembles Opposer’s EARTHY DELIGHTS trademark so as to be likely, when used on or in connection with the goods of Applicant, to cause confusion, or to cause mistake, or to deceive.

OPPOSER’S GROUNDS FOR OPPOSITION

COUNT I - Applicant’s application for registration is likely to cause confusion with

Opposer’s registered and common law EARTHY DELIGHTS trademark.

26. Opposer incorporates all prior paragraphs as if fully restated herein.

27. Opposer is the owner of a federally registered trademark for EARTHY DELIGHTS, which is registered for use in association with “gourmet food items, namely specialty vinegars” under Reg. No. 2,608,911 (“EARTHY DELIGHTS Registered Mark”).
28. Opposer’s EARTHY DELIGHTS Registered Mark is incontestable.
29. Opposer has also continuously and exclusively used the EARTHY DELIGHTS mark in commerce throughout the United States in association with the sale and offering for sale of specialty oils, creams, vinegars, dried mushrooms, fresh mushrooms, dried peppers, fresh peppers, dried tomatoes, spices, beans, lentils, rice, and pastas since as early as 1999 (“EARTHY DELIGHTS Common Law Mark”).
30. The EARTHY DELIGHTS Common Law Mark is inherently distinctive.
31. Alternatively, through its longstanding use in commerce, the EARTHY DELIGHTS Common Law mark has acquired secondary meaning.
32. Consequently, Opposer has acquired common law trademark rights in and to the EARTHY DELIGHTS Common Law Mark.
33. Applicant’s ‘838 Mark is confusingly similar to Opposer’s EARTHY DELIGHTS Registered Mark and Opposer’s EARTHY DELIGHTS Common Law Mark.
34. Applicant’s ‘838 Mark is likely, when used on or in connection with organic processed olives and olive oil, to cause confusion, or to cause mistake, or to deceive the consuming public into believing that Applicant’s goods are the same of Opposer’s goods or that Applicant’s goods originate from the same source as Opposer’s goods.
35. Consequently, Opposer hereby opposes Applicant’s ‘838 Mark on the grounds that it will cause a likelihood of confusion pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

RELIEF SOUGHT

In light of the foregoing, Opposer respectfully requests that the Trademark Trial and Appeal Board deny Applicant's application for registration.

/JAD/
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Attorneys for Opposer

PROOF OF SERVICE

I, Eric Misterovich, hereby certify and declare that on May 17, 2016, I served Opposer's Notice of Opposition on Applicant and Applicant's attorney of record via first class mail to the following addresses:

Earthy LLC
44 Green Bay Road
Winnetka, IL 60093

Daniel N. Christus
McDermott Will & Emery
227 West Monroe St.
Chicago, IL 60606-5096

/EWM/
Eric Misterovich
Revision Legal, PLLC

EXHIBIT A



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EARTHY DELIGHTS

Word Mark	EARTHY DELIGHTS
Goods and Services	IC 030. US 046. G & S: Gourmet food items, namely specialty vinegars. FIRST USE: 20000800. FIRST USE IN COMMERCE: 20000800
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76150799
Filing Date	October 23, 2000
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	May 28, 2002
Registration Number	2608911
Registration Date	August 20, 2002
Owner	(REGISTRANT) Earthy Delights, Inc. CORPORATION MICHIGAN 1161 East Clark Road Suite 260 Dewitt MICHIGAN 48820 (LAST LISTED OWNER) BB&HC, LLC LIMITED LIABILITY COMPANY MICHIGAN 6168 TAMARACK COVE MAPLE CITY MICHIGAN 49684
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	John Di Giacomo

Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20120327.
Renewal 1ST RENEWAL 20120327
Live/Dead Indicator LIVE

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NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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